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| 03/17/94 | | | |

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

THE PERIOD FOR RESPONSE:

a) is extended to run _____ or continues to run 3 months from the date of the final rejection
b) expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

Appellant's Brief is due in accordance with 37 CFR 1.192(a).

Applicant's response to the final rejection, filed 3/14/94 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:

- There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
- They raise new issues that would require further consideration and/or search. (See Note).
- They raise the issue of new matter. (See Note).
- They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: See attachment

2. Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. Upon the filing an appeal, the proposed amendment will be entered will not be entered and the status of the claims will be as follows:

Claims allowed: None

Claims objected to: None

Claims rejected: 1 - 14 and 16 - 17

However:

Applicant's response has overcome the following rejection(s):

The affidavit or request for reconsideration has been considered but does not overcome the rejection because _____

5. The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

The proposed drawing correction has has not been approved by the examiner.

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Part III DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

1. Claims 1 and 18 - 27 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, stating that communication links are established between the originating station and the called party needs clarification for a station can not be connected to a party. What is meant by "a calling party places a call to said input connection"? The term "storing stored data" is confusing for how can a stored data be stored again. How can a call be originated to the originating station of the calling party? How does the system know the telephone number of the calling party? Does the system originate the call to said originating station during the call attempt made by the calling party from the originating station? The "output" connection is considered a dangling component because it is not clear what the function if this component is. In line 31, "said calling party station" should be --said calling party--.

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In claim 18, it is not clear whether "a caller" is the same as the "subscriber". In line 22, the term "the subscriber remote telephone number" lacks clear antecedent basis because the claim previously recited "a subscriber telephone number" without the use of "remote". It is not clear as to what is meant by "connecting to the subscriber telephone station". What is being connected to the subscriber telephone station?

In claim 23, it is not clear as to what is meant by "connecting to the subscriber telephone station". What is being connected to the subscriber telephone station?

Dependent claims 19-22 and 24-27 are rejected because they depend from rejected claims 18 and 23, respectively.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1, 18, and 23 are rejected under 35 U.S.C. § 102(a) as being anticipated by the **IDT machine** disclosed Business Week articles and admitted by applicant as **Prior Art**.

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The article entitled "Rome to Bonn via New Jersey" (April 13, 1992) shows that a subscriber can call the IDT machine in the U.S. from a foreign country, hang up and wait for the IDT machine to call him/her back so that the subscriber can make outgoing calls utilizing the IDT machine. The article entitled "How Overseas Caller Can get Stateside Rates" (Dec. 2, 1991) shows that an overseas subscriber can call the IDT machine in the U.S. and hang up before it answers. Then the IDT machine calls back the subscriber and provides him/her with a second line to make outgoing calls.

In the specification (pages 3-4), applicant admits that in the above **Prior Art** system

"an input line is dedicated to a particular user. That is for each subscribing user there is a unique dedicated input line. When the user calls into the system on that line, typically allowing it to ring once, the system employed an autodialer configuration to call the user who responds by entering the desired number. The system dials that number on another line then bridges the user with it upon response by the called party."

While specific components of the above system such as the claimed "control means", telephone exchange, trunk line are not specifically shown by the reference, such components are inherent in the IDT system. For example, the machine inherently has to have control means and the called and calling station inherently have to be connected by a telephone exchange.

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Claim Rejections - 35 USC § 103

4. Claims 1, 18 and 23 are also rejected under 35 U.S.C. § 103 as being unpatentable over the **IDT machine** disclosed Business Week articles and admitted by applicant as **Prior Art**.

As discussed above, the IDT machine performs the functions of the claimed invention but the reference does not show the specific claimed components such as control means, telephone exchange and trunk line. If the use of the above components was not inherent, it would have been obvious for one of ordinary skill in the art to utilize an exchange for connecting the calling and the called party and utilize a control means for controlling the IDT machine.

5. Claims 19-22 and 24-27 are rejected under 35 U.S.C. § 103 as being unpatentable over the **IDT machine** disclosed Business Week articles and admitted by applicant as **Prior Art**.

The above Prior Art IDT machine does not provide an indication of an invalid call if the incoming call does not terminate within a predetermined period of time or if an incorrect DID is provided by the caller.

As for announcing an invalid call attempt, in the above system each subscriber has a unique dedicated input line and the subscriber must hang up after one ring. If, for example, the a calling party does not hang up after one ring (the call does not

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meet the requirement), this of course would be considered an invalid call attempt and the designer of the system can choose how to handle such invalid calls, for example, the designer can choose to provide an announcement to the calling party.

Similarly, it would have been obvious to indicate an invalid call attempt if the input provided by the calling party does not match a prestored input.

6. Claims 1 and 18-27 are rejected under 35 U.S.C. § 103 as being unpatentable over **Kahn et al** (U.S. Patent 4,086,438) in view of **Billinger et al** (US Patent 4,769,834) and further in view of **Srinivasan** (US Patent 5,185,782).

As shown in the previous Office actions, **Kahn et al** discloses an automatic interconnection system 30 for answering incoming calls and connecting the incoming call to an outgoing line for making an outgoing call. The calling party has to provide a security code which will be compared with stored codes by security code circuit 200. If a valid security code is entered by the calling party, the system will provide the calling party by a dial tone so that the calling party can make outgoing (local/long distance) calls.

The reference teaches that the calling party can call the system, dial his/her number and then hang up. In this case the system will initiate a call-back to the calling party after which

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a dial tone will be provided to that party to make outgoing calls using the system.

The reference differs from the claims in that in the reference the call is answered while in the claimed invention the call is not answered. While verifying the identity of the calling party, the reference (filed March 1977) utilizes security codes provided by the calling party. However, the claimed invention utilizes information provided by the exchange to identify the originating station (such as DID and ANI).

Billinger et al explicitly teaches the use of ANI to eliminate the need for the customer to dial an authorization code. Using ANI instead of authorization call means that the calling party can be identified without answering the call.

Utilizing the ANI provides advantages such as speed and accuracy because having the calling party manually dial his/her telephone number may cause delay and sometimes the calling party may make a mistake while dialing the number. In general, providing the number automatically is preferred over providing the number manually. Further, the calling party can be identified without having the calling party pay for the call.

Thus, while updating the **Kahn et al** system to meet the current technological standards as disclosed in **Billinger et al**, it would have been obvious to utilize the ANI to automatically identify the originating station. Numerous references teach the

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use of ANI and DID/DNIS which are provided by the telephone company in order to provide the desired services to the calling parties.

ANI (Automatic number identification) informs the system of the calling party telephone number. DNIS (dialed number identification service) and DID (direct inward dialing) provide the system with the called number that was dialed by the calling party. **Numerous references**, such as the **Srinivasan** reference, teach the use of the well known ANI and DNIS/DID in telecommunication services (see references cited below).

In view of the above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the DID/DNIS or the DID/DNIS & the ANI together (note that the invention as claimed and disclosed is not limited to using DID) in order to identify the calling party and decide how to handle the call. According the articles, the system is to be used for international calls which means that foreign countries may not provide the ANI to the U.S. networks, thus, one of ordinary skill in the art would prefer to depend on the number dialed by the calling party (DID/DNIS) in order to identify the calling party in the **Kahn** system.

As for announcing an invalid call attempt, in the above system each subscriber has a unique DID number, if for example the a calling party dials an unassigned DID number, this of

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course would be considered an invalid call attempt and the designer of the system can choose how to handle such invalid calls, for example, the designer can choose to provide an announcement to the calling party.

Response to Amendment

7. The declaration filed on 11/14/94 under 37 C.F.R. § 1.131 has been considered but is ineffective to overcome **IDT machine** disclosed Business Week articles and admitted by applicant as **Prior Art**.

First, applicant admitted (pages 3-4) of the specification that the IDT machine is **prior art** and thus applicant can not now change the admission of prior art.

Second, according to one of the articles submitted by applicant (The Economist, Sept. 12, 1992, page 79, column 2), *"One of the best known discounters, 2 1/2 year old International Discount Telecommunication (IDT), uses third-country calling to provide calls between countries"*. Thus, according to this reference which was submitted by applicant, on Sept. 12, 1992, the IDT machine was 2 1/2 years old. This means that the IDT machine was built and used in the U.S. on or before March 12, 1990.

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Third, the evidence submitted is insufficient to establish a reduction to practice of the invention in this country prior to the date of the IDT reference. It appears from the declaration that the reduction to practice was accomplished on April 2, 1992 which is NOT prior to the date of the IDT reference (Dec. 2, 1991).

8. Applicant's arguments filed 11/14/94, regarding the rejection based on Kahn, Billinger and Srinivasan, have been fully considered but they are not deemed to be persuasive.

Examiner agrees that the Kahn system is different from the claimed invention. The difference is discussed in the 103 rejection which suggest upgrading the Kahn system in view of the teachings of the secondary references.

Applicant states that "although the claimed invention utilizes the DID number, it does not identify the originating station". Examiner respectfully disagrees for claim 1 clearly recites "identifying the originating station" and the specification clearly discloses identifying the originating station.

Examiner agrees that the ANI and DID numbers are not equivalent or interchangeable, however, as discussed in the above rejection, they represent numbers that are utilized by many references in order to improve the handling of incoming calls.

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Applicant is reminded that **Inbound/Outbound Magazine** (October 1989 and May 1990) teaches the use of ANI and DNIS/DID in telecommunication systems and that **Richardson, Jr. et al** (US Patent 5,317,627) teaches the use of DNIS tables in order to provide various application after comparing the incoming DNIS number with prestored DNIS numbers.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Matar whose telephone number is (703) 305-4731.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700. The Group's new FAX number is (703)-305-9508. This FAX number is to be used only for Group 260 papers.

Ahmad F. Matar
Ahmad F. Matar
Primary Patent Examiner
Group Art Unit 2601

January 12, 1995